

**REMARKS**

Applicants appreciate the Examiner's acknowledgement of receipt of the Amendment mailed September 30, 2003 and the IDS of July 24, 2003 and the IDS mailed September 30, 2003.

By the present amendments, which are provided to place the claims in condition for allowance or put the claims in better form for appeal, the subject matter of Claim 19 has been incorporated into Claims 11, 29 and 30. Claim 19 has been cancelled.

Further, Claims 11, 29 and 30 have been amended to define the claimed invention with greater specificity by emphasizing that the starch fibers, as claimed in Claims 11, 29 and 30, as amended, have a size ranging from about 0.02 dtex to about 5 dtex. Support for these amendments is found in the Specification at page 5, lines 24-26.

The amendments made herein are made with the purpose of expediting prosecution. Applicants reserve the right to pursue claims directed to any subject matter within the present application.

No new matter has been added by this Amendment. Claims 11-18 and 20-30 are pending.

**Rejections Under 35 USC 102:**

Claims 11-15 are rejected by the Examiner under 35 USC 102(b) as allegedly being anticipated by U.S. Patent No. 5,516,815 to Buehler et al. ("Buehler"). The Examiner asserts that Buehler describes starch fibers or modified starch fibers (corresponding to the claimed starch fibers of the claimed invention). The Examiner further asserts that Buehler describes the amount of starch, that such starch fibers can be used in absorbent articles, absorbent cotton and wound dressing materials (which correspond to the claimed fiber or fibrous structure). Also, the Examiner asserts that Buehler describes the amount of plasticizer, about 50%, in the starch composition which overlaps the amount of plasticizer in the claimed invention. The Examiner concludes that Buehler describes essential limitations of the claimed invention, and thus, that the claimed invention, as claimed in Claims 11-15, lacks novelty.

Applicants respectfully disagree with the Examiner's conclusion. Applicants respectfully submit that Buehler fails to teach each and every element of the claimed invention as claimed in Claim 11, as amended, because Buehler fails to teach a fiber comprising starch that has a size of from about 0.02 to about 5 dtex. Accordingly, Applicants submit that Claim 11, as amended, and Claims 12-15, which ultimately depend from Claim 11, as amended, are not anticipated by Buehler because Buehler fails to teach each and every element of Claim 11, as amended.

Furthermore, if the Examiner's anticipation rejection is based on inherency, Applicants wish to remind the Examiner of the state of law with respect to inherency. "[A] prior art reference may anticipate without disclosing a feature of the claimed invention if that characteristic is necessarily present, or inherent, in the single anticipating reference." Schering Corp. v. Geneva Pharms., Inc., 339 F.3d 1373, 1377 (Fed. Cir. 2003). Further, "For inherent anticipation, [a prior patent] . . . must

have sufficiently described and enabled at least one embodiment that necessarily featured or resulted in the subject matter embraced by [a] limitation." Toro Co. v. John Deere & Co., 2004 U.S. App. LEXIS 784, 20. Accordingly, for Buehler to inherently anticipate the claimed invention as claimed in Claim 11, as amended, the size (about 0.02 dtex to about 5 dtex) of the starch-containing fiber as claimed in Claim 11, as amended, must be necessarily present in Buehler. Applicants respectfully submit that starch-containing fibers having a size of from about 0.02 dtex to about 5 dtex are not necessarily present in the teachings of Buehler. Applicants further submit that Buehler fails to sufficiently describe and enable at least one embodiment that necessarily featured or resulted in a starch-containing fiber having a size of from about 0.02 dtex to about 5 dtex as claimed in Claim 11, as amended.

Claims 11-18 and 20-30 are rejected by the Examiner under 35 USC 102(b) as allegedly being anticipated by U.S. Patent No. 4,243,480 to Hernandez et al. ("Hernandez"). The Examiner asserts that Hernandez describes starch fibers (corresponding to the claimed fiber comprising starch) which are made by a number of variations. The Examiner further asserts that Hernandez describes the amount of 5-40% of starch fibers which amount overlaps the claimed amount of the claimed invention of fibers made from starch. Further, the Examiner asserts that Hernandez describes plasticizers as well as other additives can be added to the fiber from starch. Also, the Examiner asserts that Hernandez describes the production of the starch into fibers with cross-linking agents and the making of the starch with about any additives up to 50% by weight. The Examiner concludes that Hernandez describes the essential components of the claimed invention, since Hernandez describes the basis structure and chemistry, the other properties would be inherent and thus, that the claimed invention, as claimed in Claims 11-18 and 20-30, lacks novelty.

Applicants respectfully disagree with the Examiner's conclusion. Applicants respectfully submit that Hernandez fails to teach each and every element of the claimed invention as claimed in Claims 11, 29 and 30, as amended, because Hernandez fails to teach a fiber comprising starch that has a size ranging from about 0.02 dtex to about 5 dtex and a Tg of at least about -30°C. The Examiner apparently found that Hernandez failed to teach the subject matter of original Claim 19 since the Examiner did not reject Claim 19 over Hernandez. Accordingly, Applicants submit that Claim 11, as amended, and Claims 12-18 and 20-28, which ultimately depend from Claim 11, as amended, are not anticipated by Hernandez because Hernandez fails to teach each and every element of Claim 11, as amended. Further, Applicants submit that Claims 29 and 30, as amended, are not anticipated by Hernandez because Hernandez fails to teach each and every element of Claims 29 and 30, as amended.

Furthermore, if the Examiner's anticipation rejection is based on inherency, Applicants submit that for Hernandez to inherently anticipate the claimed invention as claimed in Claims 11, 29 and 30, as amended, the size (about 0.02 dtex to about 5 dtex) of the starch-containing fiber as claimed in Claims 11, 29 and 30, as amended, must be necessarily present in Hernandez. Applicants

respectfully submit that starch-containing fibers having the claimed sizes, as claimed in Claims 11, 29 and 30, as amended, are not necessarily present in the teachings of Hernandez. Applicants further submit that Hernandez fails to sufficiently describe and enable at least one embodiment that necessarily featured or resulted in starch-containing fibers having the claimed sizes, as claimed in Claims 11, 29 and 30, as amended.

**Rejections Under 35 USC 103:**

Claims 11, 13-20 and 27-30 are rejected by the Examiner under 35 USC 103 as allegedly defining obvious subject matter over Buehler, identified above, in view of U.S. Patent No. 5,286,770 to Bastioli et al. ("Bastioli"). The Examiner recognizes that Buehler is silent about the amount of plasticizer and the amount of cross-linking agent. The Examiner attempts to utilize the teachings of Bastioli to overcome the deficiencies associated with Buehler. The Examiner asserts that Bastioli describes absorbent articles comprising starch with a synthetic polymer which are an interpenetrated network (corresponding to the claimed fiber starch of the claimed invention as claimed in Claims 11, 13-20 and 27-30) with plasticizer in the amount of 2-40 wt% which amount overlaps that of the claimed invention as claimed in Claims 11, 13-20 and 27-30. The Examiner further asserts that Bastioli describes the amount of the crosslinking agent urea which can also be aldehydes of about 2-7% which overlaps that of the claimed invention as claimed in Claims 11, 13-20 and 27-30. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ the plasticizer and crosslinking agents of Bastioli in the modified starch fibers of Buehler motivated with the expectation that improved moisture absorption would be evidenced as note in Buehler. Further, the Examiner concludes that regarding the properties, since the basic chemistry and structure are exemplified in the references, it would be routine in this art to optimize the size, basis weight, density and Tg since this only involves routine skill in the art.

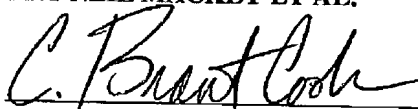
Applicants respectfully disagree with the Examiner's conclusion. Applicants respectfully submit that Buehler fails to teach each and every element of the claimed invention as claimed in Claims 11, 29 and 30, as amended, because Buehler fails to teach a fiber comprising starch that has a size of from about 0.02 to about 5 dtex. Applicants submit that Bastioli fails to overcome this deficiency of Buehler. Accordingly, Applicants submit that Claim 11, as amended, and Claims 12-18 and 20-28 (Claim 19 cancelled), which ultimately depend from Claim 11, as amended, are not rendered obvious over Buehler in view of Bastioli. MPEP 2143.03. Furthermore, Applicants submit that Claims 29 and 30, as amended, are not rendered obvious over Buehler in light of Bastioli are not rendered obvious over Buehler in view of Bastioli.

**Conclusion:**

WHEREAS, Applicants have made an earnest effort to overcome the rejections of the claims, Applicants respectfully request reconsideration of the rejections in light of the amendments and remarks contained herein and a notice of allowance of Claims 11-18 and 20-30, as amended.

Respectfully submitted,

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